UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/459,703	12/13/1999	Kiran A. Padwekar	884.027US1	1539

			EXAMINER
21186	7590	01/12/2005	MEONSKE, TONIA L

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ART UNIT	PAPER NUMBER
2183	

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/459,703	PADWEKAR, KIRAN A.
	Examiner	Art Unit
	Tonia L Meonske	2183

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _01 November 2004_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1,2 and 4-26_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1,2 and 4-26_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
    application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-8, 10, 11, 14-20, 22, and 23 are rejected under 35 U.S.C. 102(e) as being clearly

anticipated by Deao et al., US Patent 6,065,106.

3.   The rejections are respectfully maintained and incorporated by reference as set forth in

the last office action, mailed on November 1, 2004.

4.   Claims 24-26 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Deao et

al., US Patent 6,065,106.

5.   Referring to claim 24, Deao et al. have taught the computer readable medium of claim 23,

wherein the replay handler includes computer instructions which, when executed, cause the

repeatedly replaying the at least one execution to occur (Figure 45, The system code, or

computer instructions are executed. An emulation event occurs, which causes the repeatedly

replaying the at least one execution to begin occurring.).

6.   Referring to claim 25, Deao et al. have taught the computer readable medium of claim 23,

wherein the replay handler has a predetermined number of replays for the at least one execution

(Figure 45, The replay handler is predetermined to replay at least one execution.).

7.   Referring to claim 26, Deao et al. have taught the computer readable medium of claim 23,

wherein the replay handler dynamically determines the number of replays for the at least one

execution (In Figure 45, the replay handler dynamically determines the number of replays for the

at least one execution, element 4522.).

<div align="center">Claim Rejections - 35 USC § 103</div>

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section
> 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that
> the subject matter as a whole would have been obvious at the time the invention was made to a person having
> ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner
> in which the invention was made.

9.   Claims 9, 12, 13, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Deao et al., US Patent 6,065,106.

10.   The rejections are respectfully maintained and incorporated by reference as set forth in

the last office action, mailed on November 1, 2004.

<div align="center">Response to Arguments</div>

11.   Applicant's arguments filed November 1, 2004 have been fully considered but they are

not persuasive.

12.   On page 8, Applicant argues in essence:

> *"Specifically, Applicant proposes that independent claim 1 now include the feature
> "wherein in response to receiving a single replay indicator, the processor is configured
> to test itself by repeatedly executing a plurality of instructions using a replay handler
> loaded into a memory hierarchy." Deao's Figure 45, Block 4520 shows that a software
> breakpoint is required to trigger each additional emulation event. Applicant cannot find,
> and Office Action 21 and Paper 13 do not point to any passage in Deao that teaches or
> suggests the cited "replay handler" claim feature."*

However, Deao has in fact taught the cited "replay handler" claim feature. The fact that

the invention of Deao may require a software breakpoint to trigger each additional

emulation event is irrelevant. The claims merely state that in response to receiving a

single replay indicator, the processor is configured to test itself by repeatedly executing a

plurality of instructions. In Deao, when the replay indicator is received, the processor is

configured to test itself. The processor tests itself by repeatedly executing a plurality of

instructions with the help of software breakpoints. Nothing in the claims require that the

single replay indicator received is the only indicator necessary for the processor being

completely configured to test itself by repeatedly executing a plurality of instructions.

Therefore, Deao has in fact taught the cited "replay handler" and this argument is moot.

13.   On page 9, Applicant argues in essence:

"The Examiner rejected claims 9, 12, 13, and 21 based on Deao. Applicant respectfully
traverses the single reference rejection under 35 USC 103 because Deao does not teach
or suggest all of the recited claim elements. Since all the elements of the claims are not
found in the reference, Applicant assumes that Examiner is taking official notice of the
missing elements. Applicant respectfully objects to this pursuant to MPEP 2144.03 and
requests that the Examiner cite references in support of this position."

In response to Applicant's request, below are the references that teach the obvious

elements that are absent in Deao.

a.   Claim 9 states, "wherein the storage element is a hard drive". Finkelstein's

Pocket Book of technical Writing defines a hard drive as an input/output device for the

nonvolatile storage and retrieval of data. Input/output devices move information into and

out of the computer. The computer writes (or outputs) data to the hard drive and reads

(or inputs) data from the hard drive, it remains there even when the power is turned off.

See http://www.d.umn.edu/~jmackiew/comp3130_moreinfo_techdd.htm .

b.   Claim 12 states, "wherein on the replay handler being executed, the replay handler is modifiable by the host system". Borland C++ for Windows User's Guide teaches a replay handler being modified by the host system several times on pages 103-122, for example see page 119 under the section entitled "modifying an existing breakpoint".

c.   Claim 13 states, "wherein the replay handler is modified to alter starting and stopping points of one of the at least one executions" ". Borland C++ for Windows User's Guide teaches in several locations on pages 103-122, a replay handler that is modified to alter starting and stopping points of one execution, for example see page 109 under the sections entitled "stopping the program" and "Starting over".

d.   Claim 21 states, "wherein the number of times, the starting point, and the stopping point were modified by a user ". Borland C++ for Windows User's Guide teaches these limitations in several locations on pages 103-122. For example, for the limitation "the number of times", see page 119 under the section entitled "creating conditional breakpoints", for the limitation "the starting point and the stopping point", see page 109 under the sections entitled "stopping the program" and "Starting over".
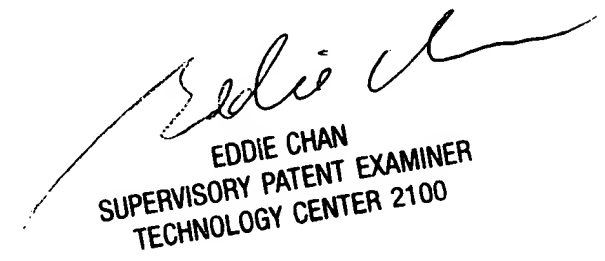
Conclusion

14.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tonia L Meonske whose telephone number is (571) 272-4170. The examiner can normally be reached on Monday-Friday, 8-4:30.

15.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eddie P Chan can be reached on (571) 272-4162. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

16.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tlm

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